

REMARKS

Reconsideration of this application is requested.

The claims have been amended to emphasize novel features of the invention. More specifically, claim 13 has been amended to specify the following: that pearlescent white finish is produced on a cured white primer surface (specification, page 9, lines 16-17; page 10, lines 18-22); that the white paint composition is applied in a spray coat fashion (specification, page 20, lines 1-4; page 6, lines 9-13, and in particular line 13; PCT CA02/01810, incorporated into the specification by reference, page 20, line 21, page 21, lines 12-13 and page 38, line 9); that the improved pearlescent white paint composition consists of (specification, Table I), rather than comprises, certain components, including non-coated mica (specification, Table I); and that the improved pearlescent white paint composition is applied to the cured white primer surface of the substrate (specification, page 9, lines 16-17; page 10, lines 18-22). (Support from the specification is parenthetically provided.) Claim 25 was amended to delete the symbol for aluminum, "Al." New claims 29 and 30 were added to independently recite slightly different embodiments of the process of claim 1. No issues of new matter are raised by the amendments.

With entry of this amendment, the pending claims are claims 13-15, 20, 23 and 25-30. All of these claims are thought to be allowable for the reasons noted herein.

Reconsideration and withdrawal of the Section 103(a) rejection of claims 13-14, 20, 23 and 25-28 based on Miyatake et al. (U.S. 2002/0043464) is requested.

Miyatake teaches a full combination of resin, TiO_2 , TiO_2 -coated mica and particulate metallic Al for use in providing, most preferably, a plurality of electro-deposited layers each formed from anionic or cationic electrodeposition coating compositions containing an electrically-conducting agent. The object of Miyatake requires three individual layers to constitute the final product.

Claim 13 of the present invention, as amended, is novel over Miyatake for at least the following reasons. As noted above, claim 13, as amended, recites a process for producing a pearlescent white finish on a cured white primer surface of a substrate wherein the white paint composition is applied in a spray coat fashion. (It is worth noting that electrocoating step in the present invention is for the primer layer and not the base coat.) The white paint composition is limited by the term "consisting of" to a film former and a solids material consisting of the three component composition, which includes non-coated mica. Miyatake, on the other hand, teaches

that the plurality of layers are electrodeposited and is silent on whether a pearlescent white finish could indeed be obtained by an electrostatic deposition process in the absence of an electrically conducting agent (anionic or cationic). Moreover, Miyatake teaches use of TiO₂ coated mica and is silent as to whether use of this compound would be capable of providing the white pearlescent finish of the present invention. Furthermore, Miyatake teaches a multilayered product and is silent on whether a plurality of layers would provide the product produced by the process of the present invention.

In sum, the process recited in claim 13 is nonobvious over Miyatake in part because Miyatake does not teach or suggest each and every element of the present invention. Moreover, given the above discussed differences between Miyatake and the process of the present invention, there is no reasonable expectation of success that the process taught by Miyatake would produce a pearlescent white finish on a cured white primer surface of a substrate.

Claims 14, 20, 23 and 25-28 depend, either directly or indirectly, from claim 13 and thus, for the reasons discussed above, should be found allowable over Miyatake. New claims 29 and 30 should be allowable over Miyatake for essentially the same reasons discussed above, noting, for example, that claim 30 recites that the white paint composition is applied in a single white pearlescent layer on the cured white primer surface, which should further distinguish it from Miyatake.

For essentially similar reasons, the Examiner is requested to reconsider and withdraw the Section 103(a) rejection of claims 13-15 20, 23 and 25-28 as unpatentable over Fowler et al. (U.S. 4,978,708). Like Miyatake, Fowler is also silent on whether the coatings described therein could possibly have a white pearlescent finish by the process and compositions described therein. The object of Fowler is to provide coatings having good pigment wetting and dispersion characteristics. Particulate pigment agents may be used to provide a "metallic" veneer effect with, for example, metallic aluminum flake and mica, as well as rheology control agents, such as silica, silicate and clays. As with Miyatake, Fowler provides no teaching that a white pearlescent finish could be obtained using its process or composition. Nor does Fowler show or suggest the specific composition used in the applicants' process; *i.e.* the combination of non-coated mica, TiO₂ and particulate metallic Al in the amounts specified in claim 13, for the applicants' purposes.

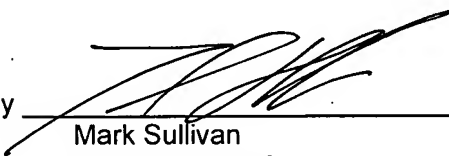
Additionally, applicants note that they have surprisingly discovered that paint compositions containing solids material with certain specific ratios of components in admixture with the film former provide greatly improved pearlescent finishes on

substrates. The present invention is much more than discovering the optimum or workable ranges by routine experimentation. The discovery of acceptable utility of a composition having a small select range of constituents is not optimization of an alleged general teaching of Miyatake or Fowler, both of which are silent on the desired utility of the present invention, *i.e.*, an advance in the art of providing a white pearlescent finish with other desirable properties. Undue experimentation requiring a myriad of experiments would have been necessary in a mere optimization process, particularly without particular guidance or motivation from the cited art.

For at least the above reasons, the Examiner is respectfully requested to reconsider the Section 103(a) rejection of claims 13-15 20, 23 and 25-28 over Fowler and the Section 103(a) rejection of claims 13-14, 20, 23, and 25-28 over Miyatake.

All issues having been addressed, the applicants respectfully submit that the application is in condition for allowance. Accordingly, allowance is requested.

Respectfully submitted,
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